

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed January 15, 2008 (Paper No. 20080106). Upon entry of this response, claims 117-128, 130-131, 149-163, and 165-187 are pending in the application. In this response, claims 117 and 149 have been amended, claims 165-187 have been added, and claims 132-148 and 164 have been cancelled. Applicant respectfully requests that the amendments being filed herewith be entered and request that there be reconsideration of all pending claims.

I. Initial Matters

Applicant notes that the Office Action Summary indicates that claim 129 is rejected, as does p. 4 of the Detailed Action. Claim 129 was cancelled in the response filed October 19, 2008. Therefore, the rejection of claim 129 will not be addressed herein.

II. Rejection of Claims 117-128, 132-146, 149-160, and 164 under 35 U.S.C. §102

Claims 117-128, 132-146, 149-160, and 164 are rejected under §102(e) as allegedly anticipated by *Nishikawa et al.* (U.S. 6,481,010). The rejection of claims 132-148 and 164 is rendered moot by claim cancellation. Applicant takes this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicant so chooses, and does not intend to dedicate any of the cancelled subject matter to the public. Applicant expressly reserves the right to present cancelled claims 132-148 and 164, or variants thereof, in continuing applications to be filed subsequent to the present application.

Applicant respectfully traverses the rejection of claims 117-128 and 149-160. A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each

element of the claim. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

A. Independent Claim 117

1. Nishikawa et al. does not disclose “enabling a user to record a first set of media programs in a first storage device associated with a digital personal video recorder (PVR)”

Nishikawa et al. describes recording programs, but only to a video cassette recorder. (“The GUI includes a TV Planner icon which, if selected by the user, causes the television to display a monthly calendar (or recording/reminder list) that indicates which programs are purchased and/or selected for recording by a VCR”, Abstract.) However, even assuming, for the sake of argument, that a video cassette recorder is a “PVR”, a video cassette recorder is not “digital” as recited in claim 117. *Nishikawa et al.* also describes storing DSS/Internet data:

Internet processing element 202 also receives DSS/Internet data from Buffer logic 204 and stores the DSS/Internet data on HDD 228. The DSS/Internet data represents, e.g., web sites that the user can access via the “Best of Web” feature of the GUI, as discussed in further detail below. Storing DSS/Internet data on HDD 228 enables a user to access predetermined web sites in real time, thereby, removing the access and interconnection delays traditionally encountered when communicating with web sites over a phone line.
(Col. 6, lines 20-35)

However, storing web sites is not recording “media programs” as recited in claim 117.

Nishikawa et al. also describes downloading program guide information:

In operation, DSS processing element 200 periodically downloads large amounts of data (e.g., program guide information, web sites for caching in HDD 228, firmware updates) to FIFO buffer 254 by signaling address decoder 258 and downloading the data to multiplexer 256.
(Col. 6, lines 50-55)

However, downloading program guide information is not recording “media programs” as recited in claim 117.

2. *Nishikawa et al.* does not disclose “storing media information corresponding to the recorded first set of media programs in the first storage device”

As discussed above in section II.A.1, the only recording of programs described in *Nishikawa et al.* is recording to the VCR. *Nishikawa et al.* also discloses a TV Planner screen 632 that displays title, date, and time of programs selected for recording. (See Col. 13, lines 20-45.) Applicant will assume, for the sake of argument, that title, date and time are “media information” as recited in claim 117. However, programs **selected for recording** are clearly not the same as “**recorded** media programs” as recited in claim 117. Furthermore, *Nishikawa et al.* does not teach that this title, date, and time are stored in the VCR where the programs are recorded, as a consistent interpretation of claim 117 requires.

Nishikawa et al. also disclose that the TV Planner screen 632 displays title, date, and time of programs “which are purchased”. (See Col. 13, lines 20-45.) *Nishikawa et al.* does not further explain the meaning of “purchased programs”. Applicant submits that purchased programs are not the same as “recorded media programs” as recited in claim 117, since a program can be purchased before it is recorded, or purchased without any recording at all.

3. *Nishikawa et al.* does not disclose “responsive to the user entering a search term, searching the first and second storage devices for media information having a high level of correlation with the search term”

The Office Action (p. 5) alleges that this “searching” feature is disclosed in *Nishikawa et al.* at Col. 3, line 61-Col. 4, line 7, Col. 9, lines 53-Col. 10, lines 35, and Col. 14, line 53-Col. 16, line 19. Applicant has reviewed *Nishikawa et al.*, and notes that the only mention of “searching” occurs in the last cited portion (Col. 14, line 53-Col. 16, line 19). In this portion, *Nishikawa et al.* discloses two types of searches: searching the electronic program guide and searching the Internet. Specifically, the portion of *Nishikawa et al.* relied on by the rejection discloses that

DSS processing element 200 generates an option palette 672 in EPG screen 650 if the user presses options key 312 on remote controller 14. Option palette 672 includes, but is not limited to, a "Search" icon 674, a "Category" icon 676, a "Calender" icon 678, and a "Guide Settings" icon 680. Preferably, highlight box (or cursor) 568 is positioned over "Search" icon 674 when option palette 672 is first displayed. If the user selects

"Search" icon 674, DSS processing element 200 generates an on-screen keyboard, as discussed below (FIGS. 17-18).
(Col. 14, lines 53-62)

Referring now to FIG. 17, an on-screen keyboard 700...slides upwardly over option palette 672 and channel table 658 if the user selects "Search" icon 674 in option palette 672. On-screen keyboard 700 allows the user to search for a desired program by entering a search term (e.g., actor's name, sport team's name, movie director's name). On-screen keyboard 700 includes a plurality of keys 702 and a window 704 for displaying search terms entered by the user via keys 702. In operation, the user manipulates keys 702 of on-screen keyboard 700 via directional keys 318-324 and enter key 326 of remote controller 14. It should be noted that the user may enter search terms via keyboard peripheral 38 (FIG. 1) if keyboard peripheral 38 is connected to integrated DSS/WebTV receiver 12.

Referring now to FIG. 18, on-screen keyboard 700 can also be accessed by the user in GUI Home screen 550. If the user accesses on-screen keyboard 700 in GUI Home screen 550, the user can enter Internet search terms via on-screen keyboard 700 in the same manner as described with respect to FIG. 17.
(Col. 15, lines 42-63)

A search of "the Internet" clearly is not a search of the first and second devices referred to in claim 117. First, claim 117 requires the first device to be "associated with a digital personal video recorder". Second, claim 117 requires a search "for media information". Even assuming, for the sake of argument, that searching the Internet is a search of multiple devices, a general search for "Internet search terms" as disclosed in *Nishikawa et al.* is not the same as a search for "media information" as recited in claim 117.

Furthermore, Applicant can find no teaching in *Nishikawa et al.* that the EPG is stored in two devices. Therefore, Applicant respectfully submits that a search of the EPG is not a search of the "first and second devices" as recited in claim 117. For at least these reasons, the rejection of claim 117 should be withdrawn.

B. Independent Claim 149

1. *Nishikawa et al.* does not disclose “enabling a user to record in memory a first set of media programs associated with the personal video recorder (PVR)”

As discussed above in section II.A.1, the only recording of programs described in *Nishikawa et al.* is recording to the VCR. A video cassette recorder is not “memory” as recited in claim 149. *Nishikawa et al.* also describes storing DSS/Internet data:

Internet processing element 202 also receives DSS/Internet data from Buffer logic 204 and stores the DSS/Internet data on HDD 228. The DSS/Internet data represents, e.g., web sites that the user can access via the "Best of Web" feature of the GUI, as discussed in further detail below. Storing DSS/Internet data on HDD 228 enables a user to access predetermined web sites in real time, thereby, removing the access and interconnection delays traditionally encountered when communicating with web sites over a phone line.

(Col. 6, lines 20-35)

However, even assuming (for the sake of argument) that hard disk drive (HDD) 288 can be considered “memory”, storing web sites is not recording “media programs” as recited in claim 149. *Nishikawa et al.* also describes downloading program guide information:

In operation, DSS processing element 200 periodically downloads large amounts of data (e.g., program guide information, web sites for caching in HDD 228, firmware updates) to FIFO buffer 254 by signaling address decoder 258 and downloading the data to multiplexer 256.

(Col. 6, lines 50-55)

However, even assuming (for the sake of argument) that HDD 288 can be considered “memory”, downloading program guide information is not recording “media programs” as recited in claim 149.

2. *Nishikawa et al.* does not disclose “storing media information corresponding to the first set of recorded media programs in the memory”

As discussed above in section II.A.1, the only recording of programs described in *Nishikawa et al.* is recording to the VCR. *Nishikawa et al.* also discloses a TV Planner screen 632 that displays title, date, and time of programs selected for recording. (See Col. 13, lines 20-45.) Applicant will assume (for the sake of argument) that title, date, and time are “media information” as recited in claim 149, and that this information is stored in “memory”. However,

programs **selected for recording** are not clearly not the same as “**recorded** media programs” as recited in claim 149. Furthermore, *Nishikawa et al.* does not teach that this title, date, and time are stored in the VCR where the programs are recorded, as a consistent interpretation of claim 149 requires.

Nishikawa et al. also discloses that the TV Planner screen 632 displays title, date, and time of programs “which are purchased”. (See Col. 13, lines 20-45.) *Nishikawa et al.* does not further explain the meaning of “purchased programs”. Applicant submits that purchased programs are not the same as “recorded media programs” as recited in claim 149, since a program can be purchased before it is recorded, or purchased without any recording at all.

3. *Nishikawa et al.* does not disclose “responsive to the user entering a search term, searching the memory for media information having a high level of correlation with the search term”

The Office Action (p. 5) alleges that this “searching” feature is disclosed in *Nishikawa et al.* at Col. 3, line 61-Col. 4, line 7, Col. 9, lines 53-Col. 10, lines 35, and Col. 14, line 53-Col. 16, line 19. As discussed above in section II.A.3, *Nishikawa et al.* discloses two types of searches: searching the electronic program guide and searching the Internet. A search of “the Internet” clearly is not a search of the memory referred to in claim 117. First, claim 149 recites that a user can record media programs in “the memory”, and *Nishikawa et al.* does not disclose recording of media programs on the Internet. Second, claim 149 requires a search “for media information”. Even assuming, for the sake of argument, that searching the Internet is a search of “the memory” referred to in claim 149, a general search for “Internet search terms” as disclosed in *Nishikawa et al.* is not the same as a search for “media information” as recited in claim 149.

C. Dependent Claims 118-128 and 150-160

Since independent claims 117 and 149 are allowable, Applicant respectfully submits that claims 118-128 and 150-160 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant requests that the rejection of claims 118-128 and 150-160 be withdrawn.

III. Rejection of Claims 130-131, 147-148, and 162-163 under 35 U.S.C. §103

Claims 130-131, 147-148, and 162-163 are rejected under §103(a) as allegedly obvious over *Nishikawa et al.* (U.S. 6,481,010) in view of *Koshimuta* (U.S. 6,515,710). The rejection of claims 147-148 is rendered moot by claim cancellation. Applicant takes this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicant so chooses, and does not intend to dedicate any of the cancelled subject matter to the public. Applicant expressly reserves the right to present cancelled claims 147-148, or variants thereof, in continuing applications to be filed subsequent to the present application.

Applicant respectfully traverses the rejection of claims 130-131 and 162-163. The addition of *Koshimuta* does not cure the deficiencies of *Nishikawa et al.* discussed above in connection with independent claims 117 and 149. Therefore, since independent claims 117 and 149 are allowable, Applicant respectfully submits that claims 130-131 and 162-163 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant requests that the rejection of claims 130-131 and 162-163 be withdrawn.

IV. Newly Added Claims

Applicant submits that new claims 165-187 are allowable over the cited references. Specifically, independent claim 171 is allowable for at least the reason that the cited references do not teach, disclose, or suggest the feature of "a processor configured by the program code to: record one of the plurality of media programs on the PVR; store a first one of the plurality of media information on the storage device, the first one of the plurality of media information describing the recorded one of the plurality of media programs; store a second one of the plurality of media information on the storage device, the second one of the plurality of media

information describing media programs that are currently being broadcast or are to be broadcast in the future...search the first and second ones of the plurality of media information to find media information having a high level of correlation with the search term". Claims 166-170 and 172-87 are allowable over the cited references for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant requests the Examiner to enter and allow the above new claims.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 117-128, 130-131, 149-163, and 165-187 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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